

UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/798,201	9/2/04	ANDREW DOWNIE, ET AL.	85170-4599

Title: DOWN-HOLE TOOL

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Art Unit	Paper Number
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Correspondence Address:

ALLAN A. FANUCCI  
WINSTON & STRAWN LLP.  
200 PARK AVE  
NEW YORK, NY. 10166

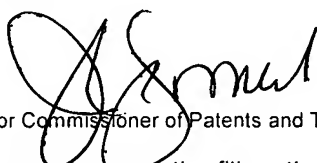
Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 536,523

Grant Date: 08-Jun-06

**This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.**

Approved:



for Commissioner of Patents and Trademark

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

### LICENSE FOR FOREIGN FILING

[Title 35, United States Code (1952) Sections 184, 185, 186]



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Allan A. Fanucci  
WINSTON & STRAWN LLP  
200 Park Avenue  
New York, New York 10186-4193

In re: Downie et al : DECISION ON REQUEST  
Serial No.: 10/798,201 : UNDER 37 CFR 5.25  
Filing date: 02 September 2004  
Docket No: 85170-4599

Title: DOWN-HOLE TOOL

In view of the communication(s) filed 03 February 2006, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 first having been obtained through error and without deceptive intent.

Country	Date
United Kingdom	15 January 2001
PCT	15 January 2002

Approved:

Andrea M. Valenti  
Patent Examiner  
Group 3643  
(571)272-6895

07 June 2006

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/798,201	02-Sep-04	ANDREW DOWNIE, ET AL.	85170-4599

Title: DOWNHOLE TOOL

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Art Unit	Paper Number
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Correspondence Address:  
ALLAN A. FANUCCI  
200 PARK AVENUE  
NEW YORK, NY 10166

PATENT & TRADEMARK OFFICE  
**MAILED**

FEB 1 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



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New York New York 10186-4193

In re: Downie et al : DECISION ON REQUEST  
Serial No.: 10/798,201 : UNDER 37 CFR 5.25  
Filing date: 02 September 2004  
Docket No: 85170-4599

Title: DOWN-HOLE TOOL

This is a decision on the petition filed on 20 August 2004 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

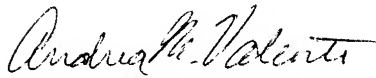
The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met.

The verified statement does not present a clear explanations as to why the material was filed abroad through error and without deceptive intent. This statement must be provided from the person authorized to decide where to initially file the application; in other words, the person that was responsible for filing of the foreign application.

The verified statement is lacking the following declaration "I hereby declare that all statements made herein of my own knowledge are and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that

willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code and that such willful statements may jeopardize the validity of the application or any patent issued thereon.”

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Andrea M. Valenti  
Patent Examiner  
Group 3643  
(703) 305-3010

21 December 2004

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS

Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/798,201	02-Sep-04	ANDREW DOWNIE, ET AL.	85170-4599

Title: DOWN-HOLE TOOL

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Art Unit	Paper Number
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Correspondence Address:

ALLAN A. FANUCCI

WINSTON & STRAWN LLP.

200 PARK AVE

NEW YORK, NY. 10166

PATENT & TRADEMARK OFFICE

**MAILED**

NOV 25 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
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In re: Downie et al : DECISION ON REQUEST  
Serial No.: 10/798,201 : UNDER 37 CFR 5.25  
Filing date: 10 March 2004  
Docket No: 85170-4599

Title: DOWN-HOLE TOOL

This is in response to the petition filed 11 April 2005 and subsequent to the decision mailed on 11 February 2005 for a retroactive license.

This is a decision on the petition response filed on 11 April 2005 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(i) have not been met.

The verified statement by Dr. Moreland fails to contain the statement that "the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order".

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be

made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



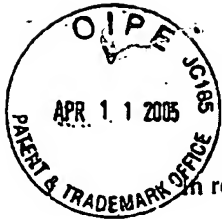
Andrea M. Valenti  
Patent Examiner  
Group 3643  
(571)272-6895

09 November 2005



04-15-05

EXPRESS MAIL NO.: EV 346 792 953 US



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re-application of: Andrew DOWNIE et al.

Confirmation No.: 6184

Application No.: 10/798,201

Group Art Unit: 3672

Filing Date: March 10, 2004

Examiner: Andrea M. Valenti

For: DOWNHOLE TOOL

Attorney Docket No.: 85170-4599

**PETITION FOR RETROACTIVE FOREIGN FILING LICENSE  
UNDER 37 C.F.R. § 5.25 and § 5.13**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition is responsive to the Communication from the Examiner dated February 11, 2005 in the above identified application. Applicants initial petition for a retroactive foreign filing license filed on August 20, 2004 was denied. Thus, applicants again request a retroactive foreign filing license for U.K. Application No. GB 0101014.9, filed January 15, 2001 in the United Kingdom; and PCT Application No. PCT/GB02/00178, filed January 15, 2002 and designating all Contracting States bound by the Patent Cooperation Treaty. Both applications were entitled "IMPROVED DOWNHOLE TOOL."

The U.K. Application No. GB 0101014.9 was filed in the name of applicant Neyrfor-Weir Limited, and the PCT Application No. PCT/GB02/00178 named one U.S. resident, Roy POWELL, residing at 269 Solomon Drive, Estates Park, CO 85017, as an inventor.

The U.S. application corresponding to the U.K. and PCT applications is U.S. Application No. 10/798,201, filed March 10, 2004 and entitled "DOWNHOLE TOOL." Named as inventors in this U.S. Application are: Andrew McPherson DOWNIE; Edward Docherty SCOTT; and Roy POWELL.

Also submitted herewith is a verified statement (declaration) of Dr. David Moreland in support of this petition, prepared in accordance with 37 C.F.R. § 5.25(a)(3).

The fee for this petition is believed to be \$130. Please charge the required fees to Winston & Strawn LLP Deposit Account No. 50-1814.

Respectfully submitted,

Allan A. Fanucci,

Reg. No. 30,256

April 11, 2005

Date

**WINSTON & STRAWN LLP**  
Customer No. 28765  
(212) 294-3311

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